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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/604,995	06/28/2000	Cory O. Nykoluk	16513-2424	6151
21888	7590	03/24/2004	EXAMINER	
THOMPSON COBURN, LLP			MAI, TRI M	
ONE US BANK PLAZA			ART UNIT	PAPER NUMBER
SUITE 3500			3727	
ST LOUIS, MO 63101				

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/604,995	NYKOLUK, CORY O.
Examiner	Art Unit	
Tri M. Mai	3727	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 2-9, 12, 13 and 16-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 2-9, 12-13, and 16-23 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 2-9, 12-13, and 16-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Mao (6279706). Mao teaches a piece of baggage having a rigid base 23, two wheels 26, a rigid towing member 30, ball-and-socket joint for connecting the arcuate handle to conform to the user as shown in Fig. 8., and a backing sheet between portions 30 and 20 in Fig. 6.
2. Claim 23 is rejected under 35 U.S.C. 102(b) as being anticipated by Zwanzig (5464081) or Liang (5464080). Zwanzig teaches a circumferentially curved telescoping handles with a ball-and socket joint that can be extended along an arcuate path (the rotating path). Likewise, Liang teaches a circumferentially curved telescoping handles with a ball-and socket joint that can be extended along an arcuate path (the rotating path).
3. Claims 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gelb (WO9638066) in view of JP' 929. Gelb teaches a backpack having a rigid base, and two shoulder straps. Gelb meets all claimed limitations except for the backing sheet. JP' 929 teaches that it is known in the art to provide a backing sheet 22. It would have been obvious to one of ordinary skill in the art to provide a back sheet in Gelb as taught by JP'929 to enable one to transport the bag comfortably.

The backing sheet and the base are twistable as claimed.

4. Claims 16 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by JP'285329. JP329 teaches a backpack having a first side 11 having two shoulder straps backing sheet at portion W is twistable with respect to the rigid bottom as claimed.

***Response to Arguments***

5. Applicant's arguments filed 12/01/03 have been fully considered but they are not persuasive. With respect to claims 16 and 17, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

6. With respect to claim 16 and 17, the claim(s) must be distinguished from the prior art in term of structure rather than function. *In re Danly*, 263 F.2d 844, 847(CCPA 1959). Furthermore, apparatus claims cover what a device is, not what a device does, *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F. 2d 1464, 1469 (CCPA 1995). See MPEP 2114. In this case, there is no structural difference in JP329.

7. With respect to the Declaration by the inventor, as set forth in the previous Office Action, the Declaration filed on 12/08/03 under 37 CFR 1.131 has been considered but is ineffective to overcome the Mao reference.

The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Mao reference to either a constructive reduction to practice or an actual reduction to practice. In fact, there is no evidence from a date prior to the date of reduction to practice prior to the filing date of the Mao reference, and the declaration can not be substituted for evidence.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri M. Mai whose telephone number is (703)308-1038. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lee W Young can be reached on (703)308-2572. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tri M. Mai  
Primary Examiner  
Art Unit 3727

*T. Mai*